

REMARKS

This communication is filed in response to the Office Action mailed on March 5, 2007. No claims are amended, no claims are canceled, and no claims have been added. As a result, claims 8-11, 19-46, 48, and 65 are pending. Claims 8-11, 19, 21-46, 48, and 65 have been withdrawn from consideration.

Interview Summary

The Applicant thanks Examiner Dinh for the courtesy of conducting a telephone interview on March 13, 2007 with the Applicant's representative Mark V. Muller. During this interview, the Examiner and Mr. Muller reviewed the concept of engaged interstices, particularly with respect to FIGs. 15 and 16 of the Application. The relationship between the conductors and the dielectric in the drawings was also discussed. Examiner Dinh and Mr. Muller agreed that Mr. Muller would go ahead with providing a response to the pending Office Action. This document includes that response.

§102 Rejection

Claim 20 was rejected under 35 USC § 102(b) as being anticipated by Komushi et al. (U.S. Patent No. 6,266,227, hereinafter "Komushi"). First, the Applicant does not admit that Komushi is prior art, and reserves the right to swear behind this reference in the future. Second, because the Office has not properly established a *prima facie* case of anticipation, the Applicant respectfully traverses this rejection.

Komushi is directed to the construction of thin film capacitors. *See* Komushi, Col. 1, lines 6-8. An object of Komushi's invention is to "provide a thin-film capacitor that can be easily produced by laminating dielectric layers and electrode layers." Komushi, Col. 2, lines 42-44. As shown, Komushi's thin film capacitor has electrode layers 2 and 3 formed on either side of a dielectric layer 1, and supported by a substrate 6. *See* Komushi, FIGs. 1 and 2; and Col. 4, lines 46-58. The capacitor "has a laminated structure in which the four dielectric layers 1 are sandwiched between a first electrode portion 10 ... and a second electrode portion 11 ...". *See* Komushi Col. 5, lines 6-10.

It is asserted in the Office Action that Komushi's "conductive layers" (electrode layers 4, 5) include interstices 2, 3, which are engaged. However, reading the cited portions of Komushi reveals that such is not the case.

First, the Applicant respectfully notes that independent claim 20 includes the following language: "a second conductive layer including a second interstice engaged with the first interstice". Thus, the first and second interstices are *engaged* (see Application, Figure 4A, elements 150, 160). To be "engaged" means "meshed," which in turn, means "interlocked." *See Webster's Ninth New Collegiate Dictionary*, G. & C. Merriam Company, pgs. 412 and 744, 1983. In other words, if one were to attempt to "pull" the conductive layers 110, 120 apart in the $\pm X$ direction in Application FIG. 16, for example, the engaged interstices 150, 160 would prevent such separation. However, this cannot be said about the electrode layers 2,3 or 4,5 of Komushi, which are simply laminated or sandwiched together without being engaged. *See Komushi*, Col. 2, lines 42-44. That is, if one were to pull on the layers 2,3 or 4,5, in opposing directions (e.g., either parallel or perpendicular to the horizontal plane of the substrate 6), no part of one layer would engage with a part of another layer (e.g., layers 2 and 3, or layers 4 and 5) to prevent the layers from being pulled apart.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). "The *identical invention* must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

Second, while claims during examination should be interpreted as broadly as their terms reasonably allow, that interpretation must be tempered by the context in which the terms are used. The *Hyatt* court states that "during examination proceedings, claims are given their

broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2D (BNA) 1664, 1667 (Fed. Cir. 2000) (emphasis added) (“During examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.”; citing *In re Graves*, 69 F.3d 1147, 1152, 36 U.S.P.Q.2D (BNA) 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 U.S.P.Q. (BNA) 1, 5 (Fed. Cir. 1985) (en banc).).

The interpretation of the term “engaged” proffered by the Office is neither reasonable, nor consistent with the specification. It is not reasonable because it does not encompass the meaning of the terms as understood by those of ordinary skill in the art, and confirmed by a standard dictionary, above. It is not consistent with the specification because it is apparent from viewing FIGs. 15 and 16 of the Application that the claimed (engaged) relationship between the Applicant’s layers 110, 120 and interstices 150, 160 is not the same as the simple layered approach taught by Komushi. *See* Application, pg. 18, line 19 – pg. 19, line 29; *see also* Application, pg. 9, lines 5-18 and FIG. 4A.

Since Komushi does not teach the existence of engaged interstices, what is disclosed by Komushi is not identical to the subject matter of the embodiment claimed, and thus, the rejection of claim 20 under § 102 is improper. Reconsideration and allowance are respectfully requested.

CONCLUSION

The Applicant respectfully submits that all of the pending claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney Mark Muller at (210) 308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

STEVE VAN KIRK

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 349-9587

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By / Mark V. Muller /
Mark V. Muller
Reg. No. 37,509

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21 day of March, 2007.

Kate Gannon
Name

Kate G
Signature